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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,094	09/19/2003	Graeme R. Middleton	014208.1630 (93-03-012)	8989
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE, 6TH FLOOR DALLAS, TX 75201-2980			EXAMINER JARRETT, SCOTT L	
			ART UNIT 3624	PAPER NUMBER
			NOTIFICATION DATE 10/29/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/666,094	<b>Applicant(s)</b> MIDDLETON, GRAEME R.	
	<b>Examiner</b> SCOTT L. JARRETT	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Non-Final Office Action is in response to Applicant's amendment filed July 10, 2008. Applicant's amendment amended claims 1-20. Currently claims 1-20 are pending.

This Office Action has been made Non-Final in order to address a new grounds of rejection under 35 U.S.C. 101.

#### ***Response to Amendment***

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

The 35 U.S.C. 112(2) rejection of claims 7, 9, 13 and 18 is withdrawn in response to Applicant's amendments to claims 7, 9, 13 and 18.

The objection to the Title of the application is not withdrawn.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Title***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: System and Method For Funding an Information Technology Initiative Based on an Assessed Strategic Value.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1-10, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 1-10 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized,

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"the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Regarding Claims 11-15, claims 11-15 do not utilize the proper computer program product format and effectively recite descriptive material (software) per se and are therefore deemed to be directed to non-statutory subject matter where there is no indication that the proposed software is recorded on computer-readable medium and capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 11-15 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Correction required. See MPEP § 2106 [R-2].

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 11 and 16 recite the limitation “the information technology initiative”.

There is insufficient antecedent basis for this limitation in the claim.

Examiner interpreted the claims to read “a information technology initiative” for the purpose of examination. Appropriate correction required.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-2, 4-8 and 10-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Riven, Paul R., Balanced Scorecard Step-by-Step (2002).

Regarding Claims 1, 11 and 16 Riven teaches a system and method for assessing needs (information technology) in a business comprising:

- gathering information associated with the operation of a business and the activities (projects, initiatives, strategies, plans, efforts, work, programs, actions, etc.) pertaining to an (information technology) initiative (project, effort, system, software, strategy, etc.) desired to be implemented (inventory current projects/initiatives;

Paragraph 1, Page 191; Paragraphs 3-4, Page 197; Exhibit 7.1);

- applying (strategic value) ratings to the activities (Bullet 1, Page 191; Bullet 1, Lines 15+, Page 193);

- categorizing (grouping, classifying, 'common criteria', strategic, non-strategic, etc.) the activities so that like activities are assessed against each other (Lines 1-3, 8-10; Last Eight Lines, Paragraph 1, Page 191; Bullet 1, Page 193; Paragraph 3, Page 197; Exhibit 7.1);

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- determining which activities within a particular category are to be funded in accordance with the applied (strategic value) ratings (Lines 1-2, Page 19; Paragraph 3, Page 188; Bullet 1, Lines 15+, Page 193; Last Paragraph, Page 230).

**Exhibit 7.1 Mapping Initiatives to Objectives**

Perspective	Objectives	Initiatives											
		Benchmarking	Maintenance Overhaul	ISO 9002	Frequent Purchase Program	IT Tools and Training	360 Feedback	Global Communication	Partner Program	Just-in-Time Mfg.	Decision Training	Facility Beautification	New Pricing Programs
Financial	Grow revenue												●
	Increase asset utilization	●								●			
Customer	Increase partnering								●				
	Build loyalty				●								
	Grow market share				●								
Internal Process	Develop customer information					●							
	Reduce downtime		●	●									
Employee Learning and Growth	Develop core competencies							●					
	Increase empowerment						●				●		

Regarding Claims 2-3, 12 and 17 Riven teaches a system and method further comprising applying an approval filter to each activity (approve for funding, development, deployment, resources, etc.; Paragraph 1, Page 19; Bullet 1, Last 8 Lines, Page 193).



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Regarding Claims 4, 14 and 19 Riven teaches a system and method further comprising calculating a (strategic value) assessment for each activity from the (strategic value) ratings (Bullet 1, Lines 15+, Page 193).

Regarding Claim 5 Riven teaches a system and method further comprising establishing funding for an activity with the highest (strategic value) assessment (Bullet 1, Lines 15+, Page 193).

Regarding Claims 6, 15 and 20 Riven teaches a system and method further comprising:

- comparing the (strategic value) assessment of a first and second activities (Bullet 1, Page 193; Exhibit 7.1);
- prioritizing the first activity with respect to the second activity in response to the comparison (Last Paragraph, Page 188; Bullet 1, Page 193; Paragraph 4, Page 197; Exhibit 7.1).

Regarding Claims 7, 13 and 18 Riven teaches a system and method further comprising applying a weight factor to each category pertaining to the initiative (Bullet 1, Lines 15-18, Page 193).

Regarding Claim 8 Riven teaches a system and method wherein the categories including strategic position, financial impact, intellectual assets or business drivers (Exhibit 7.1).

It is noted that the labels used to describe the various categories an IT initiatives merely represents non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific labels used to describe the various IT initiatives categories. Further, the structural elements remain the same regardless of the specific labels used to describe the various IT initiatives categories. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* 2106.

Regarding Claim 10 Riven teaches a system and method wherein the activities are categorized according to whether an activity transforms the business, grows the business, provides technical advantage or involves a technology refresh (Exhibit 7.1).

It is noted that the labels used to describe the various categories an IT initiatives merely represents non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited

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method steps would be performed the same regardless of the specific labels used to describe the various IT initiatives categories. Further, the structural elements remain the same regardless of the specific labels used to describe the various IT initiatives categories. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riven, Paul R., Balanced Scorecard Step-by-Step (2002) as applied to claim 1 above, and further in view of Sharmar, WO 01/16836.

Regarding Claim 3 Riven does not expressly teach applying the (strategic value) rating in response to an affirmative approval filter as claimed.

Sharmar teaches applying the (strategic value) rating in response to an affirmative approval filter (acceptance criteria; Lines 1-8, Page 6; Lines 6-18, 27-29, Page 8; Lines 18-27, Page 10) in an analogous art of assessing initiatives/projects in an enterprise for the purpose of prioritizing and selecting the business initiatives/activities (Paragraph 1, Page 6; Figure 4).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for assessing business activities as taught by Riven would have benefited from applying the strategic rating in response to an affirmative approval

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filter in view of the teachings of Sharmar; the resultant system/method enabling users to agreed on acceptance criteria (approval filters) for approving business activities.

Regarding Claim 9 Riven does not expressly teach that technical and/or risk impacts are considered as claimed.

Sharmar teaches that technical and risk impacts and a plurality of other impacts are considered for application of the (strategic value) ratings (score, value; impacts – Lines 8-12, Page 6; Lines 16-32; Figure 3; technology - Lines 21-23, Page 14; risks Lines 5-10, Page 9; financial impact - Lines 15-20, Page 9) in an analogous art of prioritizing/rating business activities for the purpose of rating and/or prioritizing business activities/initiatives based on a plurality of common impacts.

It would have been obvious to one skilled in the art at the time of the invention that the system and method of assessing needs in a business as taught by Riven would have benefited from taking into account any of a plurality of well known impacts when assessing the strategic nature of business activities (strategic value rating) including but not limited to technical and risk impacts in view of the teachings of Sharmar; the resultant system/method enabling users to account, in the strategic value rating of the initiatives/activities, the various impacts the initiatives/activities will have on the business.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Gronau et al., U.S. Patent Publication No. 2003/0069869, teach a system and method for selecting strategic plans.
- Ahamparam et al., U.S. Patent Publication No. 2003/013599, teach a system and method for optimizing technology projects (initiatives, activities within a business) including categorizing, filtering, rating/scoring and prioritizing technology projects.
- Zhu et al., U.S. Patent Publication No. 2004/0015376, teach a system and method for assessing needs within a business comprising rating/valuing, comparing and selecting projects and categorizing activities within projects.
- Vance, U.S. Patent Publication No. 2004/0181446, teach a system and method for rating, ranking and selecting business activities, strategies and initiatives.
- Buss, How To Rank Computer Projects (1983), teach a method for scoring, rating, ranking and categorizing information technology projects (initiatives, activities) within a business.
- Sarkis et al., A Decision Model For Strategic Evaluation Of Enterprise Information Technologies (2001), teach a method for assessing information technology needs in a business comprising scoring/rating, ranking, comparing and prioritizing information technologies within a business.
- Hallikainen et al., Evaluating Strategic IT Investments (2002), teach a method for assessing the information technology needs in a business.

- Berry, Getting Your Project Priorities Right (2003), teach a method for filtering, prioritizing and funding information technology activities (projects) within a business.
- Phillips et al., Align strategy and technology in three steps (2003), teach a method for prioritizing activities pertaining to information technology initiatives based on the strategic value of the initiatives.
- Schniederjans et al., A new strategic information technology investment model (2003), teaches a method for rating, scoring, comparing, ranking and selecting business activities pertaining to initiatives in a business.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/  
Primary Examiner, Art Unit 3624